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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,647	12/21/1999	ROBERT D. GORDON	B0192/7011	3881

7590 02/10/2003

JOHN R VAN AMSTERDAM
WOLF GREENFIELD & SACKS PC
600 ATLANTIC AVENUE
BOSTON, MA 02210

EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/10/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/468,647

Applicant(s)

GORDON ET AL.

Examiner

Janet L Andres

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1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,8-10,13,16-20,22-29,32-42,44,46,48-53, 57-71, 73 is/are pending in the application.
- 4a) Of the above claim(s) 5,8-10,13,16-20,22-29,32-38,48-53 and 57-71 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 and 41 is/are allowed.
- 6) ☒ Claim(s) 39, 42, 44, 46, 56, 73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Applicant's amendment filed 18 November 2002 is acknowledged. Claims 5, 8-10, 13, 16-20, 22-29, 32-42, 44, 46, 48-53, 56-71, and 73 are pending in this application. Claims 5, 8-10, 13, 16-20, 22-29, 32-38, 48-53, and 57-71 are withdrawn from consideration as being drawn to a non-elected invention.

The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Claim Rejections/Objections Withdrawn

2. The objection to claims 43 and 72 as referring to a figure is withdrawn in response to Applicant's amendment.

3. The rejection of claims 1-4, 6, 7, 11, 12, 15, 21, 30, 31, 39-47, 54-56, and 72 under 35 U.S.C. 112, first paragraph, as lacking enablement commensurate with the scope of the claims is withdrawn in response to Applicant's amendment.

4. The rejection of claims 4, 43, 45-47, 54, 55, and 72 under 35 U.S.C. 112, second paragraph, as indefinite is withdrawn in response to Applicant's amendment.

5. The rejection of claims 1-4, 6, 7, 11, 12, 15, 21, 30, 31, 40-43, 47, 54-55 and 72 under 35 U.S.C. 102(e) is withdrawn in response to Applicant's amendment.

Claim Rejections Maintained/New Grounds of Rejection

6. The rejection of claim 42 under 35 U.S.C. 112, second paragraph, is maintained. This claim is drawn to a polynucleotide of SEQ ID NO: 29. SEQ ID NO: 29 is a polypeptide; it appears to be the C-terminus of SEQ ID NO: 1.

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7. The rejection of claims 39, 42, 44, 46, and 56 under 35 U.S.C. 102(e) is maintained and applied to new claim 73 for reasons of record in the office action of paper no. 16. Claims 39, 44, 46, 56, and 73 are drawn to sequences "consisting essentially of" SEQ ID NO: 26. SEQ ID NO: 26 is a fragment of SEQ ID NO: 2 of the '311 patent. "Consisting essentially of" is interpreted as equivalent to "comprising": see MPEP §2111.03:

"A consisting essentially of claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising format." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir.1998). See also Atlas Powder v. E.I. duPont de Nemours & Co., 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); In re Janakirama-Rao, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); Water Technologies Corp. vs. Calco, Ltd., 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claim of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention.

Thus, sequences "consisting essentially of" sequences encoding SEQ ID NO: 26 encompass and are anticipated by SEQ ID NO: 1 of the '311 patent.

Claim 42 is drawn to the nucleic acid of SEQ ID NO: 29. As stated above, SEQ ID NO: 29 is a polypeptide. It is also the C-terminus of SEQ ID NO: 2 of the '311 patent and sequences "consisting essentially of" SEQ ID NO: 29 would encompass and be anticipated by SEQ ID NO: 2 of the '311 patent.

CLAIMS 40 AND 41 ARE ALLOWED. CLAIMS 39, 42, 44, 46, 56, AND 73 ARE REJECTED.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].


All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that

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sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.
February 3, 2003


YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600